

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)	MAIL STOP ISSUE FEE
)	
Barbro Moberg-Alehammar et al.)	Group Art Unit: 3761
)	
Application No.: 10/788,446)	Examiner: MICHELE M. KIDWELL
)	
Filed: March 1, 2004)	Confirmation No.: 9994
)	
For: ABSORBENT ARTICLE WITH)	
IMPROVED SURFACE MATERIAL)	
)	
)	

**REQUEST FOR RECONSIDERATION OF THE PATENT TERM
ADJUSTMENT PURSUANT TO 37 C.F.R. 1.705(b)**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Patentees hereby request reconsideration the patent term adjustment indicated in the *Determination of Patent Term Adjustment under 35 U.S.C. 154(b)* mailed with the *Notice of Allowance*. This request for reconsideration is filed no later than the payment of the issue fee, but filed after the date of mailing of the Notice of Allowance. Therefore, pursuant to 37 C.F.R. § 1.705(b), this request is timely filed.

Patentees respectfully submit that the revised patent term adjustment was incorrectly calculated in that the Office has failed to take the decision in *Wyeth v. Kappos*, No. 2009-1120, slip op. (Fed. Cir. Jan. 7, 2010) into consideration in calculating the revised patent term adjustment. In particular, the Office appears to have calculated the revised patent term adjustment on the basis that the period of delay under 35 U.S.C. § 154(b)(1)(B) and 37 C.F.R. § 1.702(b) is overlapping with every period of delay for which adjustment must be afforded under 35 U.S.C. § (b)(1)(A) and 37 C.F.R. § 1.702(a). It is understood that:

[T]he Office has consistently taken the position that if an application is entitled to an adjustment under the three-year pendency provision of 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending before the Office (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the

actual filing date of the application, is the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay “overlap” under 35 U.S.C. 154(b)(2)(A).

69 Fed. Reg. 34283 (2004). However, the Federal Circuit decision affirmed the decision in *Wyeth v. Dudas*, 88 U.S.P.Q.2d 1538 (D.D.C. 2008) which pointed out:

The problem with the PTO's construction is that it considers the application delayed under §154(b)(1)(B) during the period before it has been delayed. That construction cannot be squared with the language of §154(b)(1)(B), which applies “if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years.” (Emphasis added.) “B delay” begins when the PTO has failed to issue a patent within three years, not before.

Wyeth v. Dudas, 88 U.S.P.Q.2d 1538, 1541 (D.D.C. 2008).

Accordingly, as set forth below, Patentees are entitled to 900 days of patent term adjustment rather than the 334 days indicated *Determination of Patent Term Adjustment under 35 U.S.C. 154(b)* mailed with the *Notice of Allowance*. This is because the 438 day period of adjustment under 37 C.F.R. § 1.702(a) that began on the day after 14 months from the date that the application was filed and ended on the day that the first action was mailed and the 12 day period of adjustment under 37 C.F.R. § 1.702(a) that began on the day after 4 months from the date that a response was filed (July 6, 2009) and ended on the day that the Notice of Allowance was mailed cannot have overlapped with the 566 day period under 37 C.F.R. § 1.702(b) that began on the day after the date that is three years after the date that the application was filed and ended on the day that a Request for Continued Examination was filed. The sum of the non-overlapping periods under 37 C.F.R. § 1.702 is 1016 days. Subtracting 116 days of applicant delay under 37 C.F.R. § 1.704 results in a final adjustment of 900 days.

This request complies with the requirements of 37 C.F.R. § 1.705(b)(1) & (2) as follows:

- (1) The request is accompanied by the fee set forth in § 1.18(e); and
- (2) Below, applicants set forth a statement of the facts involved, specifying:
 - (i) The correct patent term adjustment and the basis or bases under § 1.702 for the adjustment;

(ii) The relevant dates as specified in §§ 1.703(a) through (e) for which an adjustment is sought and the adjustment as specified in § 1.703(f) to which the patent is entitled;

(iii) Whether the patent is subject to a terminal disclaimer and any expiration date specified in the terminal disclaimer; and

(iv)

(A) Any circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704; or

(B) That there were no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704.

The Correct Patent Term Adjustment and Bases Under 37 C.F.R. § 1.702

The correct patent term adjustment is 900 days. The bases under § 1.702 for the adjustment are as follows.

Under 37 C.F.R. § 1.702(a)(1), the issuance of the patent was delayed due to the failure of the Office to mail at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the date on which the application was filed. The application was filed on March 1, 2004 and a first action was not mailed until June 27, 2006.

Under 37 C.F.R. § 1.702(a)(1), the Office failed to respond to a reply under 35 U.S.C. 132 not later than four months after the date on which the reply was filed. The Office did not respond to the Reply filed July 6, 2009 until November 18, 2009.

Under 37 C.F.R. § 1.702(b), the patent was delayed due to the failure of the Office to issue a patent within three years after the date the application was filed. The application was filed on March 1, 2004 and a Request for Continued Examination was filed on September 17, 2008. No time was consumed by an interference proceeding under 35 U.S.C. 135(a), by the imposition of a secrecy order under 35 U.S.C. 181, by review by the

Board of Patent Appeals and Interferences or a Federal court, or any delay in the processing of the application by the Office that was requested by the applicant.

The Relevant Dates As Specified In 37 C.F.R. §§ 1.703(a) Through (e)

The relevant dates as specified in §§ 1.703(a) through (e) for which an adjustment is sought are as follows:

In accordance with 37 C.F.R. § 1.703(a), the period of adjustment under § 1.702(a) is the sum of the following periods:

The number of days in the period beginning on the day after the date that is fourteen months after the date on which the application was filed and ending on the date of mailing of an action under 35 U.S.C. 132 comprises 438 days. The application was filed on March 1, 2004. Therefore, the day that is 14 months after the day that the application was filed is May 2, 2005. The first action was mailed July 13, 2006. The period beginning on May 2, 2005 and ending June 13, 2006 comprises 438 days.

The number of days in the period beginning on the day after the date that is four months after the date a reply in compliance with § 1.113(c) was filed and ending on the date of mailing of a notice of allowance under 35 U.S.C. 151 was 12 days. A reply in compliance with § 1.113(c) was filed on July 6, 2009. The day that was after the date that was four months after the reply was filed was November 7, 2009. The Office did not respond to the Reply filed until November 18, 2009. The period beginning on November 7, 2009 and ending on November 18, 2009 comprises 12 days.

The period of adjustment under § 1.702(b) is the number of days in the period beginning on the day after the date that is three years after the date on which the application was filed and ending on the date a patent was issued was 566 days. The application was filed on March 1, 2004. The day after the date that is three years after the date on which the application was filed is March 2, 2007. A Request for Continued Examination was filed on September 17, 2008. Therefore, the period of adjustment under § 1.702(b) beginning March 2, 2007 and ending on September 17, 2008 is 566 days.

Whether The Patent Is Subject To A Terminal Disclaimer

The patent is not subject to a terminal disclaimer.

Any Circumstances During The Prosecution Of The Application Resulting In The Patent That Constitute A Failure To Engage In Reasonable Efforts To Conclude Processing Or Examination Of Such Application As Set Forth In § 1.704

The circumstances during the prosecution of the application that constituted a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704 were as follows: On two occasions, applicant is deemed under 37 C.F.R. § 1.704 to have failed to engage in reasonable efforts to conclude processing or examination of an application for periods of time in excess of three months that were taken to reply to any notice or action by the Office.

A final action was mailed January 25, 2008. The day after the date that is three months after the date of this mailing was April 26, 2008. A reply was filed on July 23, 2008. This period of delay was 89 days.

A non-final action was mailed March 9, 2009. The day after the date that is three months after the date of this mailing was June 10, 2009. A reply was filed July 6, 2009. This period of delay was 27 days.

The cumulative total number of days calculated under 37 C.F.R. § 1.704 is 116 days.

The Adjustment As Specified In 37 C.F.R. § 1.703(f) To Which The Patent Is Entitled

The adjustment as specified in § 1.703(f) to which the patent is entitled is the sum of the periods calculated under paragraphs (a) through (e) of 37 C.F.R. § 1.702, to the extent that such periods are not overlapping, less the sum of the periods calculated under § 1.704. That is, 450 days under 37 C.F.R. § 1.702(a), plus 566 days under § 1.702(b) for a sum of 1016 days under 37 C.F.R. § 1.702 less 116 days calculated under 37 C.F.R. § 1.704. That is, the adjustment to which the patent is entitled is 900 days.

CONCLUSION

For the foregoing reasons, the revised patent term adjustment indicated on the patent was in error. The patent term adjustment to which the patent is entitled is 900 days. Reconsideration and correction of the patent term adjustment is respectfully requested.

Respectfully submitted,

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